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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,695	12/14/2001	Folker Lieb	Bayer 9962.3-HCL/100717-5	7725
7590	04/28/2004		EXAMINER TRUONG, TAMTHOM NGO	
Howard C. Lee Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/017,695

**Applicant(s)**

LIEB ET AL.

**Examiner**

Tamthom N. Truong

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 5, 22, and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### FINAL ACTION

Applicant's amendment of 02-12-04 has been fully considered. The deletion of "D", "A-D", variables  $R^{13}$ - $R^{20}$ , and processes (A), (B), (E)-(M) has overcome the previous rejection of 112/2<sup>nd</sup>. Also the amended claim 2 has rendered moot the rejection of "lack antecedent basis". Thus, the previous rejection of 112/2<sup>nd</sup> is withdrawn herein. However, the rejection of obviousness-type double patenting (or ODP) remains outstanding as no terminal disclaimer has been filed.

Claims 6-21 have been cancelled. Therefore, only claims 1-5, and 22-26 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Double Patenting*

1. Claim 1-4, and 24-26 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10, and 11 of U.S. Patent No. 6,380,246. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reason stated in the previous action. Also, the scope of the instant claims falls within the scope of the claims in US'246. They only differ in the positions of substituents represented by variables X, Y, and Z on the phenyl ring. The compounds, having the same substituents attached to different positions on the phenyl ring, are positional isomers, *In re Norris*, (CCPA 1950) 179 F2d 970, 84 USPQ 458; also *In re Weichert*, (CCPA 1967) 370 F2d 927, 152 USPQ 247. Additionally, the scope of X, Y, Z only includes a limited number of

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substituents, specifically, a halogen, or an alkyl group. Furthermore, the halogen and alkyl groups are *ortho/para*-directing groups on the phenyl ring. Therefore, the position of X, Y, and Z as claimed herein would be obvious to the skilled artisan in this field. Currently, there is no record of a terminal disclaimer filed to overcome this ODP rejection as asserted on page 39, section (1) of the REMARKS. In the absence of said terminal disclaimer, the rejection of record is maintained for the reason(s) set forth supra.

2. **Response to applicant's 1.132 declaration to overcome the ODP rejection based on US 5,945,444, and US 5,262,383:** In view of the evidence showing superiority in killing plant damaging insects and mites wherein the substitution pattern on the phenyl group of the compound's core is contingent upon a 2,4,6 substitution pattern, which provides an increased rate of mortality for plant damaging insects of 14% as set forth in the comparative *Plutella* test of the US 5,945,444, and US 5,262,383 patents (both to Fischer et. al.), claims 1-4, and 22-25 having been previously rejected under ODP, are seen to exemplify unexpected, superior properties, and are seen to be free of the Fischer et. al. patents.

### ***Claim Objections***

3. Claim 5 is objected to because of the following informalities: Processes (A), (B), and (E)-(M) have been deleted so claim 5 appears as if it has been cancelled. Applicant is requested to rewrite claim 5 reciting only process (C). Appropriate correction is required.

4. Claim 2 (page 9, line 24), the word "membered" is misspelled as "memebered".

Correction is solicited.

5. Claims 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 22 is directed to a “*pesticidal composition*”, and claim 23 is directed to an “*herbicidal composition*”. The subject matter in those claims is not recited in US 6,380,246, and thus, it is not subjected to the ODP rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.


The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



T. Truong

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April 26, 2004



JAMES O. WILSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600